

Application No.: 09/912,490

Docket No.: 22051-00002-US1

REMARKS

This amendment is in response to the Office Action mailed February 9, 2005. In the Office Action, 12 claims were acted on. All 12 claims were rejected on prior art. Claims 1, 4, 6, 7, 10 and 12 were rejected as anticipated by Rantanen. Claims 2, 3, 5 and 8-12 were rejected as unpatentable (35 USC 103) based on a combination of Rantanen in view of Scagnelli. By this Amendment, Applicant has amended claims 1, 6, 7 and 12 and added new claims 13-18. Applicant submits that for the reasons specified hereinafter, claims 1-18 clearly patentably define over the cited art.

“Anticipation under 35 USC §102(e) requires that ‘each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’” *In re Robertson*, 49 USPQ 1949, 1950 (Fed.Cir. 1999).

As noted in section 706.02(j) of the MPEP, three criteria must be met in order to establish a *prima facie* case of obviousness.

First, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.

Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Third, there must be a reasonable expectation of success.

The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure.

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To the same effect is *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

Preambles that are essential to the claimed invention are limiting because they breathe life, meaning, and vitality into the claims. *Kropa v. Robie* 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

A basic distinction between the present invention and that described by Rantanen is that, as specified in claim 6, the claimed subject matter provides for "selectively entering lottery entries into a state lottery drawing via an internet web site." One of the steps in claim 6 is "selectively connecting the transaction server to a state lottery system." Claim 6 had been rejected as anticipated by the Rantanen reference. The rejection relied on the passage at col. 13, line 62 through col. 14, line 50 to evidence a "direct high speed connection" to the "state lottery system." The passage in the specification describes figure 16, which shows the user (1605-1607) connected through the cable television network 1601 and a duplexer and multiplexer 1604 to a computer 1507. The specification makes it clear that the computer 1507 is that of the "lottery agency" (13:54). It is not apparent that the lottery agency described in the reference is the "state lottery system" referred to in claim 6. Nevertheless, it is clear that the subject matter of claim 6 does not find correspondence in the reference. This is particularly so because the claim calls for a "internet web site" which has a "web site server" which connects in turn to a "transaction server" which in turn connects to the "state lottery system." The reference, however, shows the user connected through a cable television network (fig. 16) or the internet (fig. 15) to the "lottery agency." Applicant has been unable to find the internet web site which is reflected in the claim. The difference is believed to be significant. According to the reference, the user connects directly via the internet (or a cable television network) to the lottery agency. It is not at all apparent that this is a realistic proposal and it is one of the advantages of the invention that the users connect through the "internet web site" to the agency. It is apparent that claim 6 is not anticipated by the reference for at least this reason.

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Applicant has amended claims 1 and 7. In particular, the preamble of claim 1 has been amended to specify that the state lottery drawing to which lottery entries are entered is "administered by a state lottery agency." In addition, the claim has been amended to add a step of "communicating selected information to the state lottery agency." Claim 7 is amended in a like fashion.

Applicant submits that claims 1, 7, and 12 also distinguish from Rantanen for the same reason. In particular, claim 1 calls for entering lottery entries via an internet web site. The first step of the claim is "receiving user access at the home page of the web site." Claim 7 is similar including "means for receiving an access to the home page of the web site." In the Office Action, the step of entering the home page of the web site is read on either figures 15 or 16, relying on col. 8, lines 15-39 and col. 13, lines 40-61. These parts of the specification describe the user accessing the state lottery agency equipment. However, as has been explained above, that is not the subject matter of claims 1, 6, 7 and 12. In particular, the "web site" which is the subject matter of the first step of claim 1, is an intermediary, something different from the state lottery agency. Claim 7 is similar in specifying the presence of "means for receiving an access to the home page of the web site," where again the web site is distinctly different from the state lottery agency. Claim 12 is similar calling for "means for receiving an access at an internet web server." It is clear that the "internet web site web server" which is the subject of the first means clause of claim 12 is not the state lottery agency inasmuch as the third means clause calls for "means for selectively connecting ... to a state lottery system." Thus, the "internet web site" of claim 12 is not the state lottery agency or its resource, and thus, claim 12 distinguishes from the reference.

Applicant submits that the foregoing demonstrates that claims 1 and 7 are clearly not anticipated by the reference.

Claim 12 had been rejected on the combination of Rantanen and Scagnelli. However, Scagnelli was not relied on for any teaching related to the internet or an internet web site.

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Applicant submits that claim 12 patentably defines over the combination of references for the reasons given above.

Furthermore, the claims distinguish from the cited references on another basis. Claims 1, 7 and 12 have been amended to add a reference to a subscription service. For example, claim 1 has been amended to indicate that pre-registered users or members are presented with "a choice of member functions and content including a subscription service." Claim 7 has been amended in a similar fashion. Claim 6 has been amended to include a step of "providing access to a subscription purchasing service." Claim 12 has been amended to add "means for providing access to a subscription purchasing service." Insofar as Applicant can tell, neither reference refers to a subscription purchasing service. The subscription purchasing service subject matter is supported in the application, see for example, the subscription purchase element 52 of figure 1.

New claims 13-16 are either dependent on claims 1, 6, 7 or 12 and indicate particular characteristics of the subscription service.

Claims 17 and 18 depend on either claims 1 or 6 and indicate that members and non-members are presented with a choice of common functions and content.

In view of all of the foregoing, withdrawal of the rejection of claims 1-12, reconsideration of the application and allowance of this application with claims 1-18 is solicited.

Date: _____

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